

REMARKS

This Amendment document is responsive to the final Office Action dated August 28, 2008. Applicant appreciates the withdrawal of the rejections of claims 1, 8, and 30 under 35 USC 112, second paragraph. In light of the following remarks, Applicant respectfully requests reconsideration of the remaining final rejections.

A. FINALITY OF THE ACTION

Applicant respectfully objects to the Examiner's issuance of this "first action" final because the claims "could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114." Presently, claim 36 stands finally rejected as allegedly being anticipated by Jackson. However, the Examiner provides no basis for the rejection of this claim anywhere in the Action, and indeed references this claim only in the statement of rejection. As Applicant previously asserted, this claim expressly requires a "rigid" fiber tissue or mat. In stark contrast, Jackson teaches that the structure allegedly corresponding to the claimed tissue or mat is "soft."

The Examiner does not in any way contend that Jackson discloses the claimed rigid structure. Accordingly, claim 36 must either be recognized as allowable, or else the finality of the Action withdrawn to provide Applicant an opportunity to address whatever basis is stated for holding that this claim recites the identical invention as the prior art. Otherwise, Applicant is entitled to a patent for the invention of claim 36. 35 U.S.C. 102 ("A person **shall be entitled** to a patent **unless** . . . the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . .") (emphasis added).

B. CLAIM 1 MEETS 35 USC SECTION 112, FIRST PARAGRAPH

The Examiner finally rejects claim 1 because it allegedly violates Section 112, first paragraph, of the Patent Act. This is because the specification as filed allegedly lacks support for the limitation that the thermoplastic polymer coating is “free of random discontinuities.” However, full support for this limitation in claim 1 is found in paragraph 6 of the published application, as well as in the drawing figures (*see, e.g.*, Figure 2 illustrating the continuous, uninterrupted coating 54 free from random discontinuities covering the non-woven fiber tissue or mat 52 to thereby significantly reduce the porosity of the wall covering). These drawings undoubtedly form part of the written description, so express support is thus provided.¹

Despite previously acknowledging that Figure 2 illustrates a layer of thermoplastic polymer 54 undoubtedly continuous and uninterrupted, the Examiner contends that “the disclosure is silent as to what these discontinuities are” (Office Action mailed October 18, 2007, p. 8, ll. 4-5). The Examiner essentially wants the Applicant to prove a “negative” by showing where an intentionally omitted structure (random discontinuities) is described in Applicant’s specification or shown in the drawings. Simply put, the polymer layer 54 at issue is “free” of random discontinuities, as illustrated, which is all that claim 1 requires. Here, the requirement of Section 112, first paragraph, is clearly met, since as Applicant has pointed out and the Examiner does not contest, the polymer layer 54 shown in the drawings is continuous and thus “free of random discontinuities.” Accordingly, withdrawal of the rejection is in order.

C. THE INVENTIONS OF CLAIMS 1, 3-4, 11-12, 22, 23, 25-26, 33-34, 36, AND 40 ARE NOT ANTICIPATED BY JACKSON

¹ *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) (“drawings alone may provide a ‘written description’ of an invention as required by Section 112”).

The Examiner cites Jackson to reject claims 1, 3-4, 11-12, 22, 23, 25-26, 33-34, 36 and 40 as anticipated. A finding of anticipation is proper “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference” MPEP § 2131. In other words, the “exact same invention” must be disclosed in the reference.

Turning first to claim 1, the position taken in making the anticipation rejection disregards the plain requirements of this claim. Specifically, claim 1 requires that the claimed coating (not just the surface) is free of random discontinuities that, if otherwise present, would substantially increase porosity of the wall covering. In stark and total contrast, Jackson discloses a wall covering having a “porous polymeric ply . . . fused to and supported by a nonwoven substrate ply” (emphasis added). At column 3, lines 51-55, Jackson expressly defines “porous” and “continuous” synonymously as referring to “the existence of a multitude of small holes, openings or gaps in the polymeric ply of the wallcovering,” not just its surface. Noteworthy is the fact that Jackson, choosing to be his own lexicographer, selected a definition of the word “continuous” that does not comport with the ordinary meaning of “uninterrupted.”²

Jackson thus does not disclose, teach or otherwise suggest a coating that covers the non-woven mat in a continuous fashion (giving “continuous” its ordinary meaning) and free of random discontinuities, as shown in Applicant’s Figure 2. Quite the contrary, this reference actually teaches away from such an arrangement by virtue of the critical need for holes in the outer ply of the wall covering (see, e.g., col. 5, lines 45-51, “The key feature of the coating or plastisol application process is that the plastisol is applied very thinly to the nonwoven substate ply . . . [which]

² *Intellicall, Inc., v. Phonometrics, Inc.*, 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992) (“An inventor may “be his own lexicographer and . . . give terms uncommon meanings.”), *but cf. Jonsson v. Stanley Works*, 903 F.2d 812, 820, 14 USPQ2d 1863, 1871 (Fed. Cir. 1990) (“[w]ords in a claim . . . [are] given

results in small discontinuities, holes, or gaps, which upon fusion form miniature holes or pores in the fused polymeric ply" (Emphasis added)). Jackson is also completely silent as to whether the polymeric ply covers the nonwoven substrate in a manner that would in any way facilitate painting (not printing), including by way of a roller. Accordingly, withdrawal of the rejection of claim 1 is respectfully requested, for the cited reference does not teach the exact invention of this claim.

The Examiner also asserts in the Action that "the present invention does not preclude having micropores." Applicant respectfully submits that this is irrelevant as to the consideration of whether Jackson discloses the exact same invention as set forth in claim 1. The Examiner is improperly comparing the teachings of Applicant's specification with the prior art, rather than the express requirements of the claims.

Turning to claim 23, the Examiner does not in any way contend that Jackson discloses a layer of paint roller-applied to a thermoplastic polymer coating on a nonwoven fiber tissue or mat. Rather, the contention is made that "the manner in which the paint is applied is not relevant to the final product being claimed." Applicant respectfully disagrees with this conclusion, which not only lacks support in any authority cited by the Examiner, but is also contrary to precedential decisions previously cited by the Applicant. *See Hazani v. U.S. International Trade Commission*, 44 USPQ2d 1358 (Fed. Cir. 1997) (holding that the limitation "chemically engraved" in a claim describes the product more by its structure than by the process used to obtain it.); *see also In re Garnero*, 412 F.2d 276, 278-79, 162 USPQ 221, 223 (CCPA 1969) ("it seems to us that the recitation of the particles as 'interbonded one to another by interfusion between the surfaces of the perlite particles' is as capable of being construed as a structural limitation as 'intermixed,' 'ground in place,' 'press fitted,' 'etched,' and 'welded,' all of which at one time or another have been

their ordinary and accustomed meaning.")

separately held capable of construction as structural, rather than process, limitations"). Upon reconsideration, it is believed that the Examiner will agree that withdrawal of the rejection is in order.

Claim 40 requires a thermoplastic polymer with mineral filler forming a visible outer, non-smooth roller paintable surface of a wall covering with a non-woven tissue or mat having a visible inside surface as well. As noted above, Jackson specifically extols a smooth outer surface, and concomitantly disparages a non-smooth outer surface. *See, e.g.,* col. 2, lines 5-12, "there exist[s] a need for a . . . wall covering having a relatively higher permeability, yet which has a smooth outer exposed surface." The Examiner agrees that Jackson "provides a polymeric ply *having a smooth continuous appearance.*" (Office Action, p. 4, line 1) (emphasis in original). Despite the fact that Jackson teaches a smooth surface, this claim requiring the exact opposite structure as that taught in the prior art reference cited is rejected as being anticipated. Respectfully, the Examiner's position regarding the anticipation of claim 40 by Jackson is not supported by any substantial evidence, and withdrawal of the rejection is in order.

The Action also states that "it is the Examiner's interpretation that the materials disclosed by JACKSON are equivalent to those described by Applicant's own Specification as to produce the claimed 'non-smooth surface'" and therefore "the surface of Jackson is not smooth." *Id.* (emphasis added). That Jackson may or may not use "equivalent" materials is simply irrelevant to whether a smooth surface is formed. Jackson can use fillers and still produce a smooth surface, as he expressly teaches is desirable. The only way to conclude otherwise is to ignore the express teaching of Jackson that a smooth surface is desired, rather than the claimed non-smooth one, which cannot properly be done.

D. THE INVENTIONS OF CLAIMS 2, 8, 24, 30 AND 37 ARE

NEITHER ANTICIPATED NOR RENDERED OBVIOUS BY JACKSON

Although believed to be allowable as dependent on an allowable base claim, Applicant notes the independent patentability dependent claim 2, requiring the outer surface of the polymer coating have a surface tension of at least approximately 30 dynes/cm, and dependent claims 8 and 30, which require a specific water vapor transmission rate. The Examiner acknowledges that Jackson is completely silent as to the claimed surface tension and vapor transmission rate, and no other reference is cited as allegedly supplying these missing teachings. However, the conclusion is nevertheless reached, without citation to any substantial evidence, that such a surface tension and water vapor transmission rate would be “inherent” to the product of Jackson because it allegedly uses the same starting materials, “like” manufacturing processes, and produces “similar” end products. As a result, the Examiner concludes the inventions of these claims are unpatentable. Without discussion, the same analysis is applied in rejecting dependent claim 24 and independent claim 37, which also require a polymer coating have a surface tension of at least approximately 30 dynes/cm.

These rejections contravene not only to the Manual of Patent Examining Procedure, but also precedential decisions holding that “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”³ Not only do the steps described for forming the claimed wall covering differ completely from those outlined in Jackson, but Applicant’s processing involves a treatment designed to impart a particular surface tension in order to facilitate roller painting, as well as a certain vapor transmission rate. As acknowledged in the record, Jackson fails to mention the surface tension of the

substrate or any steps taken to alter it, and actually uses different materials. Accordingly, it cannot possibly render the inventions of claims 2 or 37 obvious.

In the alternative, the Examiner asserts that the “presently claimed function of surface tension . . . would have obviously been provided as a result of the product of” Jackson, apparently relying on a theory of “obviousness by inherency.” However, “[t]hat which may be inherent is not necessarily known” and “[o]bviousness cannot be predicated on what is unknown.”⁴ Moreover, “a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection.”⁵ Since Jackson nowhere contemplates, teaches, suggests, or even discusses surface tension to improve the roller paintability of a wall covering, it standing alone cannot possibly make it known to provide a surface tension within the claimed range.

Looking at the situation from a different perspective, Jackson does not “enable” a skilled artisan to make a wall covering having the claimed surface tension. There can be no doubt that Jackson does not describe Applicant’s claimed invention sufficient to place it in possession of a person of ordinary skill in the art, when in fact the particular surface tension claimed by the Applicant is not even remotely mentioned. Accordingly, it cannot be the case that Jackson renders the claimed inventions unpatentable, and withdrawal of the rejections is in order.

**E. CLAIMS 5-7, 9-10, 13, 27-29, 31-32, 35, AND 38-39 ARE PATENTABLE
OVER JACKSON AND NUCCI ET AL.**

Claims 5 and 27 require that the thermoplastic coating of the corresponding independent claims is a “matrix polymer resin” selected from the group consisting of low density polyethylene, high density polyethylene, polypropylene, and

³ See *Ex parte Levy*, [No West Cite] 17 USPQ2d 1461, 1464 (BPAI 1990) and MPEP § 2112, generally.

⁴ *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966).

⁵ *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

combinations thereof. In the Action, the Examiner acknowledges that no such teaching is found anywhere in Jackson. Therefore, reliance is made on U.S. Patent No. 6,265,067 to Nucci et al. as a secondary reference allegedly supplying the teaching missing from Jackson that would render the inventions of these claims obvious.

The Examiner's position ignores the express statement in Jackson that a "key feature of the coating or plastisol application process is that the plastisol is applied very thinly to the nonwoven substate ply . . . [which] results in small discontinuities, holes, or gaps, which upon fusion form miniature holes or pores in the fused polymeric ply." (see, e.g., col. 5, lines 45-51). Absolutely no substantial evidence or rational underpinning supports the conclusion that modifying the porous layer of Jackson to "provide" it with the "composition" of Nucci, as alleged, would retain this "key feature." Indeed, the Examiner does not in any way explain how using the composition of Nucci the desirable small holes or pores in the ply would be retained in the product of Jackson, or why there is a teaching, suggestion, or motivation to combine the references. Moreover, even if the teachings of these references are combined, there is no reasonable expectation of successfully achieving the stated objectives and, in fact, it appears that "key features" would be eliminated. Such is inimical to a finding of obviousness.

The Examiner also contends that it would have been obvious to combine the references "with the motivation of producing a surface material that combines some of the properties of both paper sheets . . . and plastic sheets." Aside from lacking any evidentiary support or being based on a rational underpinning, this is not at all a reason for combining the teachings of the references. Rather, it is mere speculation of what might result from making the combination. Accordingly, a *prima facie* case of obviousness is lacking.

Claims 9, 10 and 31-32 require an opacifying agent in the coating sufficient to create opacity in the range of 70-90%. Nowhere does Jackson nor Nucci disclose providing such an opacity range, and the Examiner does not in any way contend otherwise in the final Action. Thus, a *prima facie* case of obviousness is lacking, and the rejections would be reversed on appeal.

Claims 6-7 and 28-29 require a mineral filler to form a non-smooth outer surface. These claims stand rejected based on the combination of Jackson in view of Nucci. However, Jackson expressly teaches that such a feature is not a desirable attribute of a wall covering (*see, e.g.*, col. 2, lines 5-12, "there exist[s] a need for a . . . wall covering having a relatively higher permeability, yet which has a smooth outer exposed surface."). Indeed, Jackson extols the desirability of providing a wall covering with a smooth outer surface (see Abstract, line 1), and simply does not contemplate in any way imparting a mineral filler to create a non-smooth outer surface to facilitate roller painting.

When properly interpreted, Jackson thus actually teaches away from the claimed invention, and otherwise fails to motivate a skilled artisan to combine the teachings of Nucci to provide a wall covering with a non-smooth outer surface formed using mineral filler. *See, e.g. In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant."). By disregarding this teaching, the Examiner simply refuses to consider Jackson "as a whole," as required by numerous precedential decisions.

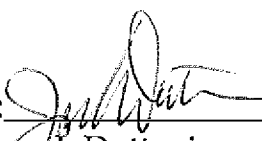
With specific regard to claims 13, 35, and 38 each further requires that the polymeric material which is the coating comprises approximately a 45/5/50 by

weight mixture of high-density polyethylene, titanium dioxide, and a dispersion, said dispersion comprising ground calcium carbonate and ground titanium dioxide in high density polyethylene. The primary reference to Jackson specifically requires a plastisol as a component of the polymer coating, which by definition includes a plasticizer. Such is clearly excluded by the plain terms of these claims, which do not recite a plasticizer as a part of the 100 weight percent of the polymeric material.

Nucci does nothing to cure this deficiency or otherwise supply the missing teaching necessary to conclude that Applicant's claimed inventions are obvious. In a previous Action, the Examiner cited to a portion of Nucci discussing certain percentages of materials. However, nowhere does Nucci state that these materials are in a coating, as the claims at issue expressly require. Accordingly, neither Nucci nor Jackson disclose the claimed coating having the specific composition of these claims, and therefore cannot render the inventions *prima facie* obvious.

In view of the foregoing remarks, Applicant submits that all claims are allowable and respectfully requests favorable reconsideration (especially with respect to claim 36, for which no basis of rejection is stated). In the event any issues remain, the Examiner is invited to telephone the Applicant's undersigned attorney, and may debit any fees due from Deposit Account 50-0568.

Respectfully submitted,

By: 
James J. Dottavio
Reg. No. 40,360

Dated: 10-15-08
Owens Corning
2790 Columbus Road, Route 16
Granville, Ohio 43023-1200
(740) 321-7167